

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.	10/820,275	Confirmation No.:	8587
Applicant(s)	Hugh T. Conway		
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Group Art Unit:	3767		
Examiner:	Catherine Witezak		
Docket:	P-5690		
Customer No.:	26253		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO ELECTION REQUIREMENT

Sir:

This document is being filed in response to the Office Action mailed February 23, 2006 in connection with the above-referenced application.

The Examiner asserts that the application defines four groups of separate species, identified as:

A: Needle Assembly

AI: Embodiment in Figure 1.

AII: Embodiment in Figure 21.

AIII: Embodiment in Figure 27.

B: Holder

BI: Embodiment in Figure 2.

BII: Embodiment in Figure 22.

C: Hub

CI: Embodiment in Figure 15.

CII: Embodiment in Figure 23.

D: Actuator

DI: Embodiment in Figure 13.

DII: Embodiment in Figure 24.

The Examiner has stated:

“Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (XI or XII or XIII, etc.) from each of the 4 groups (A, B, C, D) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none are generic.”

Provisional Election and Traversal

The Examiner has requested an election to species of the subject matter specified in the four groups (A, B, C, D).

Applicant respectfully traverses the election requirement with respect to Groups A through D. Applicant contends Claims 1 to 34 are generic to all alleged species and that searching all embodiments would not induce an undue burden on the examiner for examination.

Applicant notes that different embodiments are exemplified in

- i) Figures 1-20, 26A, and 26B ;
- ii) Figures 21-25: and
- iii) Figure 27.

However Applicant respectfully points out that there are currently no independent claims limited to any of these embodiments.

For example when comparing the independent product claims 1, 19, and 22 to the alleged groups of species (see table on next page), all independent claims are generic to all the alleged species as well as the above embodiments.

Claim 1	Claim 19	Claim 22
A shieldable needle assembly comprising:	A blood collection assembly comprising:	A blood collection assembly comprising:
a needle cannula having a proximal end and a distal end;	a needle cannula;	a needle cannula;
a hub mounted to the needle cannula at a location spaced from the distal end;	a hub mounted on the needle cannula;	a hub mounted on the needle cannula;
a shield axially slidable over the needle cannula between a fully retracted position and a fully extended position encapsulating the distal end of the needle cannula;	a spring biased telescoping shield mounted on the hub and slidable between a fully retracted position and a fully extended position encapsulating a distal end of the needle cannula;	a telescoping shield mounted on the hub and slidable between a fully retracted position and a fully extended position encapsulating a distal end of the needle cannula;
a first biasing member biasing the shield towards the fully extended position;		a spring mounted on the hub biasing the telescoping shield towards the fully extended position;
a lock for releasably maintaining the shield in the fully retracted position;		a lock on the hub holding the telescoping shield in the fully retracted position;
	a needle holder having a first end mated with the hub and a second end adapted for receiving a blood collection container; and	a needle holder having a first end mated with the hub and a second end adapted for receiving a blood collection tube;
an actuator for releasing the lock; and		an actuator moveably mounted on the hub for releasing the lock, wherein the actuator is activated by insertion of a blood collection tube in the needle holder; and
a retaining member engageable with the shield, wherein activation of the actuator causes the lock to be released with the retaining member preventing the shield from moving toward the fully extended position when engaged therewith, and wherein the shield is prevented from moving to the fully extended position until the retaining member is disengaged from the shield.	a retaining member moveably mounted on the hub and engageable with the telescoping shield when a blood collection container is received in the needle holder, wherein the retaining member holds the telescoping shield from moving toward the fully extended position when engaged therewith, and wherein removal of the blood collection container from the needle holder causes the retaining member to disengage from the telescoping shield, thereby releasing the telescoping shield such that the telescoping shield will move toward the fully extended position.	a retaining member moveably mounted on the hub and engageable with the telescoping shield when a blood collection tube is positioned within the needle holder, wherein insertion of a blood collection tube in the needle holder activates the actuator to cause the lock to be released from the retaining member holding the shield against the spring bias, and wherein removal of the blood collection tube from the needle holder disengages the retaining member from the telescoping shield, releasing the spring bias and allowing the telescoping shield to be moved in a direction toward the fully extended position.

In view of the foregoing, Applicant respectfully requests the Examiner withdraw the election requirement and **examine all claims 1-34**. Applicant also reserves the right to further define the invention with respect to the claims of non-elected claims, or file divisional applications directed to the non-elected claims and/or species.

Election

Should the examiner maintain the grounds for election, or propose an alternative ground, the Applicant elects claims 1-34 as embodied in species AI, BI, CI, and DI with traverse, reserving the right to amend and resubmit the claims readable on all other non-elected species in Groups A, B, C, and D, for rejoinder under MPEP 821.04 should a generic claim become allowable. Applicant also reserves the right to further define the invention, or file divisional applications directed to the non-elected groups and/or species.

Applicant believes no fees are due in connection with filing this response. However, if any fees are due the Assistant Commissioner is hereby authorized to charge them to Deposit Account No. 02-1666.

If the Examiner has any questions or comments relating to the present application, he or she is respectfully invited to contact Applicant's agent at the telephone number set forth below.

Respectfully submitted,

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